

Applicant : B. Jack Longley
Serial No.: 09/980,572
Filed : October 31, 2001
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REMARKS

Claims 91-98 are pending in the subject application. No claim has been added, canceled or amended herein. Accordingly, claims 91-98 are still pending and under examination.

In view of the arguments set forth below, applicant maintains that the Examiner's objections and rejections made in the March 30, 2005 Office Action have been overcome, and respectfully requests that the Examiner reconsider and withdraw same.

Obviousness-Type Double Patenting Rejection

The Examiner rejected claims 91-98 under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 50-57 of copending Application No. 09/474,478.

In response, but without conceding the correctness of the Examiner's rejection, applicant submits herewith as **Exhibit 1** a Terminal Disclaimer signed by an authorized officer of the assignee of record, The Trustees of Columbia University in the City of New York. Accordingly, applicant maintains that the obviousness-type double patenting rejection of claims 91-98 has been obviated.

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Summary

Applicant maintains that the claims pending are in condition for allowance. Accordingly, allowance is respectfully requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number provided below.

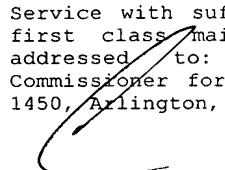
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
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New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF
Commissioner for Patents, P.O. Box 1450, Arlington, VA 22313-1450


Alan J. Morrison
Reg. No. 37,399

6/28/01
Date



Dkt. 0575/58434-B-PCT-US/JPW/AJM/NS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : B. Jack Longley
Serial No.: 09/980,572 Examiner: Ralph Gitomer
Filed : October 31, 2001 Art Unit: 1651
For : METHODS FOR INHIBITING CUTANEOUS INFLAMMATION AND
HYPERPIGMENTATION

1185 Avenue of the Americas
New York, New York 10036

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TERMINAL DISCLAIMER

The Trustees of Columbia University in the City of New York, ("Columbia University"), West 116th Street and Broadway, New York, New York 10027, is the assignee of record of the entire right, title and interest in the above-identified application by virtue of an assignment filed in connection with PCT International Application No. PCT/US00/12405, of which U.S. Serial No. 09/980,572 is a §371 national stage entry, which was executed on May 12, 2000 and recorded in the United States Patent and Trademark Office at Reel No. 011120, Frame 0952. A copy of the Assignment is attached hereto as **Exhibit A**. The above-identified application is a §371 national stage entry of PCT International Application No. PCT/US00/12405, which is a continuation-in-part and claims priority of U.S. Serial No. 09/474,478.

Columbia University is also the assignee of record of the entire right, title and interest in U.S. Serial No. 09/474,478 by virtue of an assignment which was executed on February 25, 2000 and recorded in the United States Patent and Trademark Office at Reel No. 012950, Frame 0411. A copy of the Assignment is attached hereto as **Exhibit B**.

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Columbia University hereby disclaims, except as provided below, the terminal portion of the statutory term of any patent granted on the above-identified application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 of any patent granted on U.S. Serial No. 09/474,478, and hereby agrees that any patent issued from the subject application shall be enforceable only for and during such period that the legal title to such patent shall be the same as the legal title to any patent granted on U.S. Serial No. 09/474,478, this agreement to run with any patent granted on the subject application and to be binding upon the grantee, its successors and assigns. In making the above disclaimer, Columbia University does not disclaim the terminal part of any patent granted on the subject application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173 of any patent granted on U.S. Serial No. 09/474,478, in the event that said patent later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

I have reviewed the documents attached hereto and certify that, to the best of my knowledge and belief, The Trustees of Columbia University in the City of New York is the assignee of all right, title and interest in and to the subject application. I am authorized to sign on behalf of The Trustees of Columbia University in the City of New York.

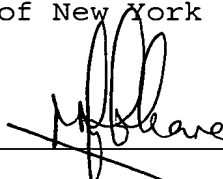
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I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: June 28 2005

The Trustees of Columbia University in
the City of New York

By: _____

A handwritten signature in black ink, appearing to read 'Michael Cleare', is written over a horizontal line.

Michael Cleare, Ph.D.
Executive Director
Science & Technology Ventures
The Trustees of Columbia
University in the City of New
York

ASSIGNMENT

In consideration of One Dollar (\$1.00), and other good and valuable considerations, the receipt of which is hereby acknowledged, We, the undersigned,

B. Jack Longley, residing at 49 Woodstock Road, Hamden, Connecticut, 06517, United States of America.

Hereby sell, assign and transfer to The Trustees of Columbia University in the City of New York, a corporation of the State of New York, having a place of business at West 116th Street and Broadway, New York, New York 10027, U.S.A., its successors, assigns and legal representatives, the entire right, title and interest for all countries, in and to any and all inventions which are disclosed and claimed, and any and all inventions which are disclosed but not claimed, in the PCT International Application, which has been executed by the undersigned on May 12, 2000.

and is entitled

METHODS FOR INHIBITING CUTANEOUS INFLAMMATION
AND HYPERPIGMENTATION

(PCT International Application No. PCT/US00/12405, filed May 5, 2000, a continuation-in-part and claiming priority of U.S. Serial No. 09/474,478, filed December 29, 1999, a continuation-in-part of U.S. Serial No. 09/306,143, filed May 6, 1999.)

and in and to said PCT International Application and all divisional, continuing, substitute, renewal, reissue, and all other applications for U.S. Letters Patent or other related property rights in any and all foreign countries which have been or shall be filed on any of said inventions disclosed in said PCT International Application; and in and to all original and reissued patents or related foreign documents which have been or shall be issued on said inventions;

Agree that said Assignee may apply for and receive U.S. and foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said U.S. and foreign Letters Patent or other rights, the priority of the aforesaid PCT International Application under the provisions of the International Convention of 1883 and later modifications thereof, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries, execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property

herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

B. Jack Longley [L.S.]

Date: 12 May 2000 B. Jack Longley

Witness R. D. Bailey
3603 Third Avenue 12H
BRONX, New York 10456

Assignment

In consideration of One Dollar (\$1.00), and other good and valuable considerations, the receipt of which is hereby acknowledged, I, the undersigned,

B. Jack Longley, residing at 49 Woodstock Road, Hamden, CT 06517, U.S.A.

Hereby sell, assign and transfer to The Trustees of Columbia University in the City of New York a corporation of the State of New York having a place of business at West 116th Street and Broadway, in the County of New York and State of New York, 10027, U.S.A., its successors, assigns and legal representatives, the entire right, title and interest for all countries, in and to any and all inventions which are disclosed and claimed, and any and all inventions which are disclosed but not claimed, in the application for United States Patent, which has been executed by the undersigned on February 25, 2000 and is entitled

METHODS FOR INHIBITING CUTANEOUS INFLAMMATION AND HYPERPIGMENTATION

(U.S. Serial No. 09/474,478, filed December 29, 1999, a continuation-in-part of U.S. Serial No. 09/306,143, filed May 6, 1999)

and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for U.S. Letters Patent or other related property rights in any and all foreign countries which have been or shall be filed on any of said inventions disclosed in said application; and in and to all original and reissued patents or related foreign documents which have been or shall be issued on said inventions;

Authorize and request the Commissioner of Patents of the United States to issue to said Assignee, the corporation above named, its successors, assigns and legal representatives, in accordance with this assignment, any and all United States Letters Patent on said inventions or any of them disclosed in said application;

Agree that said Assignee may apply for and receive foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said foreign Letters Patent or other rights, the priority of the aforesaid United States patent application under the provisions of the International Convention of 1883 and later modifications thereof, under the Patent Cooperation Treaty, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries, execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Date: 2/25

00
#

Witness: Aileen Smalls
Aileen SMALLS
596 Edgecombe Ave
New York NY 10032

B Jack Longley

[L.S.]

B. Jack Longley

Date: _____ 19

Witness: _____

[L.S.]